UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/716,531	09/19/96	MAHE Y	016800-111

18M1/0127

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EXAMINER	
HUFF,S	
ART UNIT	**PAPER NUMBER**
1806	

DATE MAILED: 01/27/98

Pl ase find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action

Application No.	Applicant(s)
08/716,531	Mahe et al
Examiner	**Group Art Unit**
Sheela J. Huff	1806

THE PERIOD FOR RESPONSE: [check only a) or b)]

a) ☐ expires _____ months from the mailing date of the final rejection.

b) ☐ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

☒ Appellant's Brief is due two months from the date of the Notice of Appeal filed on *Jan 15, 1998* (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on *Jan 15, 1998* **has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:**

☒ The proposed amendment(s):

☐ will be entered upon filing of a Notice of Appeal and an Appeal Brief.

☒ will not be entered because:

☒ they raise new issues that would require further consideration and/or search. (See note below).

☐ they raise the issue of new matter. (See note below).

☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.

☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: *Applicant's amendment to claim 1 is unclear. Commas and the insertion of a wherein clause might help.*

☒ Applicant's response has overcome the following rejection(s):
IF, IF the amendment had been entered, the rejections under 112 would be withdrawn.

☐ Newly proposed or amended claims _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.

☒ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:
see attached

☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: *none*

Claims objected to: *none*

Claims rejected: *1-11 and 16-19*

☐ The proposed drawing correction filed on _____ ☐has ☐has not been approved by the Examiner.

☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ .

☐ Other

SHEELA J. HUFF
PRIMARY EXAMINER
ART UNIT 1806

Advisory Action

1. With respect to the Ferreira et al, applicant argues that pain cannot be equated with inflammation. As stated in the previous Office action pain is a component of inflammation.

Applicant argues that treatment of pain does not always treat inflammation and cites Chapter 12. Table 12-1 shows that 2 out of 18 compounds only treat pain and not inflammation. Thus, this supports the Examiner's rejection in that it is more likely than not and one would reasonable expect the compounds to treat both pain and inflammation. Furthermore, the assay in the reference is a rat paw pressure test and the condition is induced by IL-1beta. As indicated in col. 1 of the reference, IL-1 describes two inflammatory proteins. Thus, IL-1beta is a known inflammatory agent. Thus the disclosure and claims of the reference read on the treatment of inflammatory pain.

2. With respect to Oluyomi et al, applicant argues that the reference does not state inflammation. Applicant is directed to the previous office which highlights the section indicating that the compounds are used for INFLAMMATORY PAIN.

Applicant argues that the reference cites Hiltz and Hiltz shows that their peptides had no anti-inflammatory effect. It is noted that this passage is in the discussion and is summarizing the prior art and the evidence in the Oluyomi et al reference clearly shows

that they peptides do have the effect. Applicant is directed to the discussion of the test models used--one of the models used is a formalin test and as stated on page 137, this test is similar to the administration or carrageenin which causes inflammatory hyperalgesia (ie inflammatory pain). Thus, this disclosure is directed to the treatment of inflammatory pain.

3. Thus, all of the art rejections are maintained. Applicant's arguements to the 103 rejections is essentailly the same as above, because the primary references are the same.

Sheela J. Huff

1/26/97

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